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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,711	12/05/2003	Rick L. Murphy	03-40219-US-C	4226

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EXAMINER

CHENG, JOE H

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/729,711

Applicant(s)

MURPHY, RICK L.

Examiner

Joe H. Cheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities: The term "This application is related to United States Patent Application Serial No. 10/090,460 entitled "METHOD, DEVICE AND SYSTEM FOR PROVIDING EDUCATIONAL SERVICES," filed March 4, 2002, which is hereby incorporated herein as if set forth herein in the entirety.." on paragraph 1 should be recited as --This is a continuation of United States Patent Application Serial No. 10/090,460, filed March 4, 2002, which is hereby incorporated by reference in the entirety.--, so as to clarify the status. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation therein is unclear and confusing. It is noted that without the "detecting" step (as per claim 1), or the "detector" (as per claim 8), or the "code for detecting" (as per claim 15), the method, or system, or computer program product for providing educational service cannot perform the function of automatically and temporarily interrupting of the at least one activity as claimed. In addition, the antecedent basis for "said retrieving" (as per claim 6) is lacking. Further, the term "at least one microprocessor device, comprising:" (as per claim 8) should be recited as --at least one microprocessor device--, so as to clarify the confusion.

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Furthermore, claims 3-5, 7, 10-14 and 17-21 are rejected for incorporating the above errors from their respective parent claims by dependency.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12 and 15-20 of copending Application No. 10/090,460. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 8-13, 15, 16 and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cook et al (U.S. Pat. No. 5,727,950). Cook et al discloses a computerized method for providing educational service to at least one user (student 101 in Fig. 1) engaging in at least one activity (see column 10, lines 59 and 60). The activity is automatically monitored by an agent (108), which acts as a virtual tutor for the student (see column 12, lines 20-23 and 46-47). The agent is an on-screen icon which "instruct, motivates, engages and guides its student" (see column 6, lines 3-4). The agent automatically and temporarily interrupts the engaging in the activity depending upon the detecting (see column 13, lines 33-36). (A "meta response" is a response sent directly to the agent from the student (see column 13, lines 10-17)). While Cook et al does not explicitly state that the interruption is temporary, it is submitted that it is because the function of a tutor or guide is to interrupt a student temporarily to provide guidance or help with a problem and then allow the student to resume the activity. Additionally, the interaction between the agent and the student is clearly associated with educational activities, as required by the last limitation in claim 1. Further, Cook et al also provides the claimed system and computer program product as claimed in claims 7 and 15 (note Section 5.2 beginning in column 19).

#### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 2, 4-6, 12, 14, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al (U.S. Pat. No. 5,727,950) in view of LoSasso et al (U.S. Pub. No. 2003/0008266 A1). It is noted that the teaching of Cook et al does not specifically disclose the at least one activity comprises at least one of operating a software application, surfing the web, participating with instant messaging (as per claims 2 and 16), retrieving data from at least one remote database by using a Uniform Resource Locator address (as per claims 4 and 18), or generating at least one Hyper Text Transfer Protocol request (as per claims 5 and 19) as required. However, the teaching of LoSasso et al broadly discloses the automatically presenting educational services to at least one user by the agent during the interrupted, retrieving data from at least one remote database by using a Uniform Resource Locator address, or generating at least one Hyper Text Transfer Protocol request (see Figs. 1-21). Hence, it would have been obvious to one of ordinary skill in the art to modify the method and system of Cook et al with the features of the at least one activity comprises at least one of operating a software application, surfing the web, participating with instant messaging, using a Uniform Resource Locator address to retrieve data, or generating Hyper Text Transfer Protocol request as taught by LoSasso et al as both Cook et al and LoSasso et al are directed to the method and system for providing educational services

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to at least one user engaging in at least one activity, so as to provide the educational services during the interrupting and retrieving data through the internet. It is also noted that the teachings of Cook et al and LoSasso et al do not explicitly disclose the communications device is a telephone (as per claim 12) as required. However, such feature of using the telephone as the communications device is old and well known, and is considered an arbitrary obvious design choice, so as to use the telephone of the communications devices for providing educational service.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kershaw et al (U.S. Pat. No. 5,827,070) - note Figs. 1-100F;

Trenholm et al (U.S. Pat. No. 6,234,806 B1) - note Figs. 1-12;

Freeman et al (U.S. Pat. No. 6,301,462 B1) - note Figs. 1-7;

Ginter et al (U.S. Pub. No. US 2002/0112171 A1) - note Figs. 1-87;

Brewer et al (U.S. Pub. No. US 2002/0156857 A1) - note Figs. 1-7B;

Guheen et al (U.S. Pat. No. 6,519,571 B1) - note Figs. 1-97.

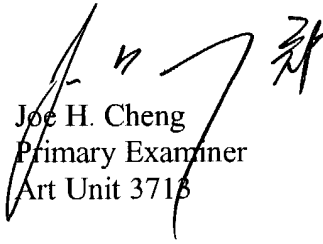
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Tue.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703)308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Joe H. Cheng  
March 31, 2004



Joe H. Cheng  
Primary Examiner  
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